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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM KRESS BODIN and DERRAL CHARLES THORSON

Appeal 2008-0637
Application 10/047,018
Technology Center 2100

Decided: June 16, 2008

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. INVENTION

The invention at issue involves indicating client device status for client devices for displaying digital objects included in email (Spec. 1). In particular, a transcoding gateway stores client device records and receives an email capability status request that includes a domain identification (*id.* 45-46). Based on the request, the transcoding gateway provides a corresponding email display capability status record for the corresponding domain (*id.* 46).

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A method of email administration comprising the steps of:
 - receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;
 - receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification;
 - finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes; and
 - sending at least one of the email display capability status attributes to the sender.

C. REJECTION

Claims 1, 4-8, 11-15, and 18-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,092,114 (“Shaffer”). Claims 2, 3, 9, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer and U.S. Patent No. 5,339,361 (“Schwalm”)

II. CLAIM GROUPING

“When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(vii) (2006).¹

Appellants argue claims 1, 4-8, 11-15, and 18-21 as a first group (App. Br. 7-19) and claims 2, 3, 9, 10, 16, and 17 as a second group (App. Br. 19-22). We select claim 1 as the sole claim on which to decide the appeal

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

of the first group and claim 2 as the sole claim on which to decide the appeal of the second group.

III. CLAIMS 1, 4-8, 11-15, AND 18-21

As set forth above, we select claim 1 as the sole claim on which to decide the appeal of claims 1, 4-8, 11-15, and 18-21. The Examiner finds that Shaffer discloses each element of claim 1 at col. 1, ll. 55-67; col. 2, ll. 1-27, 30-65; col. 6, ll. 6-67; and col. 7, ll. 1-38 (Ans. 4-5).

Shaffer discloses that “[w]hen a client device is first used to access email stored at the local server, the client device is polled to identify its access capabilities” (col. 6, ll. 40-42). An electronic message “and attachment may be generated at one of the local client devices **14**, **16**, and **18** for access at another local client device,” (col. 6, ll. 15-18) and is transmitted “from the remote client device **24** to the local server **12**” (col. 6, ll. 6-7). It is further “determined whether the attachment is accessible at the target client device without conversion” (col. 6, ll. 54-55) which is based on “all of the access capabilities of various client devices that are used to access email stored at the local server **12**” (col. 6, ll. 37-39). Also, “the protocol message may be forwarded to the originating client device **24**” (col. 7, ll. 31-32), which “may be formatted to trigger an automatic conversion and retransmission of the attachment in an alternative file format (col. 7, ll. 36-38).

Appellants argue that the “email display status attribute” recited in claim 1 “describes the status of an email display capability such as, for example, whether a display device is powered on or powered off” (App. Br. 10) and that “Shaffer’s access capabilities . . . have nothing whatsoever to do with email display status attributes claimed in the present application” (*Id.* 12). We find that claim 1 does not recite that the “email display status attribute” is synonymous with “whether a display device is powered on or off” as Appellants appear to argue. Rather, as Appellants state, the Specification merely discloses one example of an email display capability “such as” whether a display device is powered on or powered off.

In the absence of an explicit definition of “display status attribute” we broadly but reasonably construe the term using an ordinary and customary meaning of a characteristic (i.e., “attribute”) of a condition (i.e., “status”) pertaining to showing information (i.e., “display”). Under this interpretation, we find that the “access capabilities” (col. 6, ll. 42-43) that “identifies all of the access capabilities of various client devices that are used to access email stored at the local server 12” (col. 6, ll. 37-39) constitute “display status attributes” recited in claim 1 because the access capabilities of the client devices in Shaffer indicates characteristics of the condition of the client devices that identify if the various devices have the capability to access (or display) an attachment “at the target client device without conversion” (col. 6, ll. 54-55).

Appellants argue that “Shaffer’s email server never once receives an email display capability status request” (App. Br. 13). As set forth above, Shaffer discloses that the server polls client devices “to identify its access capabilities” (col. 6, ll. 42-43). “The polling process may also be used to . . . update a lookup table that is compiled within memory of the server or within memory of an adjunct device” (col. 6, ll. 43-46). The “access capabilities received at the server describe “whether the attachment is accessible at the target client device without conversion” (col. 6, ll. 54-55). We find that the access capabilities describe one or more email display capability statuses as recited in claim 1 because the access capabilities of Shaffer describe the capability of “various client devices” to access (or display) the email attachment (i.e., the status of the client devices as being able to display attachments). Thus, we find that Shaffer discloses the server receiving from a client device one or more access capability statuses (i.e., display status attributes) that describe email display capability statuses.

Appellants argue that “Shaffer is clearly oriented to a single target/client device and not to the display capability status request for an entire domain as claimed in the present application” (App. Br. 13; *see also* App. Br. 17, 18). However, Shaffer discloses that the server receives “access capabilities of various client devices that are used to access email stored at the local server 12” (col. 6, ll. 36-38). We broadly but reasonably construe the term “various client devices” to include “different kinds or categories” of client devices. Even assuming that “a domain” requires more

than one client device as Appellants assert, we find that Shaffer discloses more than one client device because Shaffer's disclosure of "various client devices" includes more than one client device using the ordinary and customary meaning of the term "various."

Appellants argue that "Shaffer does not disclose an email display capability status. In fact, Shaffer never once mentioned the status of anything" (App. Br. 14). As set forth above, we use the ordinary and customary meaning of the term "status" to include a "condition" or "state" of an object or entity. Because Shaffer's "access capabilities" of client devices describe a condition or state of the client devices (i.e., ability or accessibility to an attachment without conversion – col. 6, ll. 54-55), we disagree with Appellants' assertion that Shaffer "never once mentioned the status of anything" (App. Br. 14).

Appellants argue that "determination of whether a client device is capable of accessing an attachment discloses nothing whatsoever regarding email display capability status as claimed in the present application" (App. Br. 17) and that "[n]othing in Shaffer ever detects or advises a sender of . . . whether the email display capability of the device is powered on or when a capability was recently used" (App. Br. 17). As set forth above, although the Specification provides an example of a capability status as being a status of being on or off, we do not find, and Appellants do not point out, an explicit definition of the term in the Specification. As described *supra*,

under a broad but reasonable interpretation, we find that Shaffer discloses the claimed display capability status.

Appellants also argue that Shaffer does not disclose “sending at least one of the email display capability status attributes to the sender” as recited in claim 1 (App. Br. 17-18). As set forth above, Shaffer discloses the server determines “whether the remote format converter 32 has capabilities beyond that of the local system” and “receives the message with a converted attachment . . . [that is] forwarded to the originating client device” (col. 7, ll. 23-33). We find that Shaffer discloses sending (i.e., “forwarding”) a message to the originating client device (i.e., “the sender”), the message containing information that indicates the capability of accessing or converting an attachment (i.e., a display capability status attribute). We therefore disagree with Appellants that Shaffer fails to disclose the features of claim 1.

For the reasons set forth above, we find that Appellants have failed to demonstrate Examiner error in the rejection of claim 1. Therefore, we affirm the rejection of claim 1 and of claims 4-8, 11-15, and 18-20, which fall therewith.

IV. CLAIMS 2, 3, 9, 10, 16, AND 17

Appellants argue that “the proposed modification of Shaffer in fact does not teach or suggest each and every element of claims 1, 8, and 15” (App. Br. 20). As set forth above, Appellants have not shown Examiner

error in identifying each and every element of claim 1. Therefore, we are unpersuaded by Appellants' argument.

Appellants also argue that "the Office Action does not point to an explicit teaching in either Shaffer or Schwalm that suggests or motivates the combination of Shaffer and Schwalm" (App. Br. 22).

The Examiner finds that "both Shaffer . . . and Schwalm . . . teach an email messaging/electronic information transfer system" (Ans. 20). Schwalm further discloses that the "system for controlling access" "includes a verification mechanism and a secure storage medium with templates" (col. 1, ll. 60-63). Based on the disclosure of Shaffer and Schwalm, we find that email messaging and data transmission systems are known systems and methods in the art. Schwalm further demonstrates that utilizing a verification mechanism and a secure storage medium are also known methods in the art and that incorporating the verification mechanism into a data transmission system provides no more than expected and predictable results (i.e., transmission of data in a secure manner). Because the combination of the teachings of Shaffer and Schwalm constitutes re-arrangement of elements that are known in the art, operating the known elements with the same function that each known element had been known to perform, and yielding expected and predictable results, we find that the combination of references would have been obvious to one of ordinary skill in the art. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable

results. . . . [W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Therefore, we affirm the rejection of claim 2 and of claims 3-5, 7-10, 12-15, and 17-20, which fall therewith.

V. ORDER

In summary, the rejections of claims 1-21 under § 103(a) are affirmed.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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